



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,579	02/23/2004	David Angus Grant Jenkinson	SOMMR-012US	9576
7663                      7590                      06/10/2009 STETINA BRUNDA GARRED & BRUCKER 75 ENTERPRISE, SUITE 250 ALISO VIEJO, CA 92656				
EXAMINER				
FEENEY, BRETT A				
ART UNIT		PAPER NUMBER		
3624				
MAIL DATE		DELIVERY MODE		
06/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/784,579

**Applicant(s)**JENKINSON, DAVID ANGUS  
GRANT**Examiner**

BRETT FEENEY

**Art Unit**

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-16 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 05/26/2004 and 04/01/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Status of the Claims**

1. The following is a **NON-FINAL** office action in response to Applicant's submission received on 04/09/2009.
2. Claims 1 - 29 were subject to a restriction requirement wherein Applicant elected, without traverse, to pursue Group I consisting of claims 1-7, 9-16, 25-26 and 27-29 in the instant application. Claims 8, 17-20, 21-22 and 23-24 are herein withdrawn from consideration.
3. Claims 1-7, 9-16, 25-26 and 27-29 are currently pending and have been examined.

### **Objections**

4. The dependent claims are replete with language that reciting: "A method as claimed" however, the dependent claims should positively refer back to the claim from which it depends. For example, Claim 2 may recite: The method of claim 1.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters are used repetitively for each Figure. For example, in Figure 5b object 1 is a computer, whereas in Figure 6 object 1 is a radar chart, in Figure 7 object 1 is a clipboard, etc. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet

should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### **Rejections under § U.S.C. 112**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 1 – 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- Claim 1 recites "*communicating said scores as a characteristic of said entity*". It is not clear how scores are a characteristic of an entity, as scores have only been assigned to marketing-related dimensions. Further, it is not clear if the scores are assigned based on the performance of the entity at a given dimension or if the score is assigned based on the importance of the dimension to the entity. Therefore the claim is indefinite on its face. The Examiner has interpreted scores as a characteristic of said entity to mean that the scores are related to business

performance. Dependent claims are rejected under § 112 second paragraph as depending on indefinite claim 1.

- Claim 2 recites “idea forming; relationship building; behaviour activation; help or support; and product or service or environment experience.” The claim is indefinite on its face. The Examiner has interpreted the claim to mean the marketing dimensions are relationship building, behaviour activation, one of help or support and one of product experience, service experience or environment experience.

#### **Rejections under § U.S.C. 101**

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1 – 7 and 9 – 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
9. Claims 1 – 7 and 9 – 16 are directed to a method. However, the recited steps of the method are held to be non-statutory subject matter because the recited steps of the method are (1) not tied to another statutory class or (2) not transforming the underlying subject matter to a different state or thing.

10. Claims 25 – 26 and 27 – 29 are directed to an apparatus and manufacture, respectively. However, the recited components of the apparatus appear to lack the necessary physical components (hardware) to constitute a machine or manufacture under § 101. Therefore, these claim limitations can be reasonably interpreted as computer program modules or software *per se*. The claims are directed to functional descriptive material *per se* and hence non-statutory.

### Rejections under § U.S.C. 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the

art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

13. Claims 1, 2, 5, 9 – 13, 16, 25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., (US 2004/0068431 A1).

#### **Claim 1**

Smith discloses a method for quantifying and communicating marketing-related information relating to an entity, comprising:

- *assigning a score to each of a plurality of pre-determined marketing-related dimensions* (see at least paragraphs 0029-0032; noting "market responsiveness", "product development effectiveness", "sales effectiveness", "customer responsiveness" and the like are all marketing metrics that are measured (i.e. scored) based on a plurality of driving metrics.);
- *each score being out of a pre-determined maximum possible score* (see at least paragraph 0020; noting, "[v]alues of each of the prime measures for one of the aggregate measures may be calculated.");
- *communicating said scores as a characteristic of said entity* (see at least paragraph 0024; noting "[t]he value of at least one of the prime measures from at least one of the selected subsets may be calculated to provide an indication of the business performance.").

Smith does not explicitly teach that the score is out of a maximum possible score *per se*. However, Smith does teach that the component scores (prime measures) are evaluated against a total possible index score. Smith teaches a market responsiveness index (see paragraph 0163), that is comprised of a plurality of marketing indices. In one example, a Market Cover Index Score is calculated based on the number of possible markets that can be covered (59), and the number of markets actually covered (16), to demonstrate that the company is covering 27% of their potential markets (see paragraph 0208). In the instant example, the maximum possible score would be 100%. It would have been obvious to a person of ordinary skill in the art, at the time of the invention, to modify the method for quantifying and communicating marketing-related information relating to an entity such that each dimension score is out of a maximum potential score because calculating a maximum potential score is an effective way of benchmarking performance.

## Claim 2

Smith teaches the limitations above. Furthermore, Smith discloses:

- *wherein said pre-determined marketing-related dimensions are: idea forming; (see at least paragraph 0158; noting, "product development effectiveness" is a metric of idea forming related to products); relationship building (see at least paragraph 0164; noting "customer [] relationships"); behaviour activation (see at least paragraph 0158; noting "market responsiveness"); help or support (Id. Noting "customer responsiveness"); and product or service or environment*



*experience* (see at least paragraph 0165; noting "sales effectiveness". Further, the Examiner notes that while Smith teaches the aforementioned marketing-related dimensions; as claimed, the marketing-related dimensions are directed to non-functional descriptive data that is not functionally involved in the steps recited. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* ' 2106.

#### **Claim 5**

Smith teaches the limitations above. Furthermore, Smith discloses:

- *A method as claimed claim 1, further comprising representing each of said scores visually* (see at least FIG 5; noting relationships of measures are shown visually.).

Smith does not explicitly teach visually depicting the scores, however Crockett does (see FIG 9 and associated text; noting scores are graphed using a radar chart).

It would have been obvious to a person of ordinary skill in the art, at the time of the invention, to combine the method for quantifying and communicating marketing-related information relating to an entity taught by Smith with the step of graphing scores on a radar chart taught by Crockett because radar charts are conventional charts, that

are well understood by those in the art, and therefore allows users to visually depict and disseminate pertinent marketing assessment information to stakeholders.

### Claim 9

Smith teaches the limitations above. Furthermore, Smith discloses:

- *A method as claimed in claim 1, further comprising:*
- *assigning planned or target scores to each dimension* (see at least paragraph 0226; noting "target market index". Each dimension taught by Smith includes a highest potential obtainable metric against which the actual obtained metric is evaluated.);
- *subsequently determining actual scores for each dimension, thereby enabling comparison of the target and actual scores* (see at least paragraph 0276-0279; noting, the actual sales closed are evaluated against a total number of sales opportunities to determine a sales close metric. The Examiner notes that "thereby enabling comparison of the target and actual scores" is optional language which does not further limit the claims as they can always be omitted. "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

**Claim 10**

Smith teaches the limitations above. Furthermore, Smith discloses:

- *A method as claimed in claim 1, further comprising entering the scores into a computer* (see at least paragraph 0156; noting Smith teaches implementing the method on a computer.).

**Claim 11**

Smith teaches the limitations above. Furthermore, Smith discloses:

- *A method as claimed in claim 1, wherein said scores correspond with measurable objectives or achievements for said entity* (see at least paragraph 0350; noting metrics are the prime measure of "performance objectives".).

**Claim 12**

Smith teaches the limitations above. Furthermore, Smith teaches benchmarking projects over time in order to compare similar projects (see at least paragraph 0602).

**Claim 13**

Smith teaches the limitations above. Furthermore, Smith discloses:

- *A method as claimed in claim 1, wherein the method is performed for a plurality of entities within an overall entity* (see at least paragraph 0027; noting "the

plurality of business aspects may comprise at least a demand management aspect, a supply management aspect, and a support services aspect.”).

#### **Claim 16**

Smith teaches the limitations above. Furthermore, Smith discloses:

*A method as claimed in claim 1, adapted for use in an application selected from a group comprising: benchmarking against competitive brands/products. (Id. at **Claim 12**. However, the Examiner notes that language such as “adapted for use” does not further limit the claim because it is not positively recited. Further, the endeavor pursued by practicing the instant method does not further limit the method unless it is functionally claimed. Therefore, the recited group of applications is directed to non-functional descriptive material and therefore does not further limit the claim).*

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., (US 2004/0068431 A1), in view of **Official Notice**.

#### **Claim 14**

Smith teaches the limitations above. Furthermore, Smith does not explicitly teach touchpoints *per se*. However, the Examiner takes **Official Notice** that touchpoint mapping is old and well known in the art. Further, Applicant has admitted (see paragraph 0111), that “touchpoint mapping is commonly known”. It would have been obvious to a person of ordinary skill in the art, at the time of the invention, to combine

the method for quantifying and communicating marketing-related information relating to an entity taught by Smith with touchpoint mapping taught by **Official Notice** because touchpoint mapping improves customer communication thereby improving customer relationships and increasing business/sales with the customer.

15. Claims 3, 4, 6, 7, 15, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., (US 2004/0068431 A1), in view of Crockett (US 2004/0039631 A1).

### **Claim 3**

Smith teaches the limitations above. Smith does not explicitly disclose, however Crockett teaches:

- *A method as claimed in claim 1, wherein the total of said scores is limited so as not to exceed a pre-determined maximum possible total (see at least FIG 6 and associated text; noting "Max Potential Weighted Score").*

It would have been obvious to a person of ordinary skill in the art, at the time of the invention, to combine the method for quantifying and communicating marketing-related information relating to an entity taught by Smith with the step of having a maximum total score because having a maximum total score for comparable projects allows one to assess projects of differing scopes based on trends in overall strengths and weaknesses of the component parts; thereby enabling companies to assess and

provide additional resources, training and the like to areas that require improvement or support.

#### Claim 4

Smith/Crockett teaches the limitations above. Furthermore, Smith discloses:

- *A method as claimed in claim 3 comprising five pre-determined dimensions (see at least paragraph 0025; noting "selected subset of prime measures for each aggregate measure may consist of between five and nine prime measures.");*

Smith does not explicitly disclose, however Crockett teaches:

- *wherein each dimension is assigned a score, and wherein the pre-determined maximum possible total (see at least paragraph 0029; noting Crockett teaches a predetermined maximum score that "is distributed among the components and the capabilities within each component". Further, see paragraph 0032; noting "scorer can assign a maximum score". Crockett teaches a different scale than the instant claim, however the Examiner also notes that the choice of scale is directed to a design choice that does not further limit the step of the method. Matters of design choice does not patentably distinguish a claimed invention over the prior art. "Matters relating to ornamentation only which have no mechanical function can not be relied upon to patentably distinguish the claimed invention from the prior art", *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Further, rearrangement of parts that does not modify the operation of the claimed invention to distinguish it over the prior art have been held unpatentable, *In re**

Japiske, 1818 F.2d 1019, 86 USPQ 70 (CCPA 1950); *In re Kuhle*, 526 F. 2d 553, 188 USPQ 7 (CCPA 1975).).

It would have been obvious to a person of ordinary skill in the art, at the time of the invention, to combine the method for quantifying and communicating marketing-related information relating to an entity taught by Smith with the step of having a maximum total score because having a maximum total score for comparable projects allows one to assess projects of differing scopes based on trends in overall strengths and weaknesses of the component parts; thereby enabling companies to assess and provide additional resources, training and the like to areas that require improvement or support.

#### **Claim 6**

Smith/Crockett teaches the limitations above. Furthermore, Crockett teaches:

- *A method as claimed in claim 5, further comprising plotting said scores in a radar chart format (Id. Further, while Crockett teaches a radar chart; the Examiner notes that matters of design choice does not patentably distinguish a claimed invention over the prior art. Id. at Claim 4).*

#### **Claim 7**

Smith/Crockett teaches the limitations above. Furthermore, Crockett teaches:

- *A method as claimed in claim 6, further comprising plotting said scores (Id. The Examiner notes that the object that the scores are plotted: "on paper pre-printed*

*with radial arms labelled with said pre-determined dimensions, the radial arms incorporating marker points indicating positions at which possible scores may be represented"* does not further limit the method step. The article that is acted upon does not functionally change the step of the method and therefore is directed to a design choice *Id.* at **Claim 4.**).

#### **Claim 15**

Smith teaches the limitations above. Smith does not explicitly disclose weighted objectives, however Crockett teaches:

- A method as claimed in claim 1, further comprising recording data of a type selected from a group comprising one or more weighted objectives that represents full attainment of one or more planned or target scores (see at least FIG 7B and associated text; noting weighted scores are derived based on a potential (i.e. target) score. However, the Examiner notes that the limitation above is directed to non-functional descriptive data.).

It would have been obvious to a person of ordinary skill in the art, at the time of the invention, to combine the method for quantifying and communicating marketing-related information relating to an entity taught by Smith with the step of weighting objectives taught by Crockett because weighting objectives allows users to rank objectives based on their importance to success thereby allowing the company to concentrate resources on components that drive projects and processes to a successful



conclusion.

**Claims 25 – 29 recite limitations addressed in the claims above and are therefore rejected for similar reasons.**

### **Conclusion**

The following references are considered pertinent to Applicant's invention and have not been applied as prior art in the instant office action.

- Shimizu et al., (US 2003/0037014 A1 and US 7,346,588 B2), discloses a system and method for analyzing dimensions on a processing facility and company unit. The method includes scoring the dimensions and depicting the dimensions graphically via a radar chart.
- Bowman et al., (US 20030061246 A1), discloses a system and method for modeling and scoring business operations.
- Bennett (US 2003/0208429 A1), discloses a system and method for managing a portfolio of projects.
- Baxter et al., (US 2004/0199417 A1), discloses a system and method for assessing products based on marketing goals.
- Caplan et al., (US 2005/0096950 A1), discloses a system and method for assessing and optimizing customer relationships based on business objectives.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Brett Feeney** whose telephone number is **571.270.5484**. The Examiner can normally be reached on Monday-Thursday, 7:30am-6:30pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **BRAD BAYAT** can be reached at **571.272.6704**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***  
**Washington, D.C. 20231**

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Art Unit: 3624

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/BRETT FEENEY/

Examiner, Art Unit 3624

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624